REMARKS

Claims 11-30 are currently pending in the present application.

The Examiner has now indicated that claims 15, 17 and 23 are withdrawn from consideration. Claims 12 and 13, which were previously withdrawn, have apparently been rejoined by the Examiner.

Provisional Election With Traverse

Applicants would like to make their provisional election, with traverse, completely clear to the Examiner, for the third time during the prosecution of the instant application, in hopes that prosecution can advance to an examination on the merits some 3½ years after entering the national stage.

Based upon the Examiner's original election requirement set forth in Paper No. 8, as best as it can be understood, Applicants again provisionally elect:

> a cosmetic composition comprising: (a) a mixture of at least one fatty acid (polyglycol) ester, at least one fatty alcohol (polyglycol) ether, and at least one alkylene glycol, the mixture present in an amount of from 30 to 70% by weight; and (b) one or more oil components in an amount of from 70 to 30% by weight; said percentages by weight based upon a total weight of the mixture and the one or more oil components,

with traverse, for prosecution on the merits.

Furthermore, to the extent that Applicants' election of fatty acid (polyglycol) esters was unclear as to whether fatty acid (polyglycol) esters or fatty acid esters were being elected, as implied by the 6/04 Office Action and the 11/04 Office Action, Applicants again provisionally elect **fatty acid (polyglycol) esters**, with traverse, for prosecution on the merits.

Applicants respectfully request that the Examiner contact Applicants' undersigned representative by phone if any further election is required to allow prosecution on the merits to proceed.

Traversal of the Original Restriction Requirement and Request for Reconsideration

Applicants again respectfully traverse the original election requirement, and the additional/modified requirements set forth in the 6/04 Office Action and the 11/04 Office Action. The basis for Applicants' traversal is set forth below. First, however, for the purposes of clarifying the record for Applicants' future Petition From Requirement For Restriction Under 37 C.F.R. §1.144, Applicants' request that in the next Official Communication, the Examiner confirm or repudiate the following position he has previously taken:

> The Examiner contends that Unity of Invention practice and 37 C.F.R. §1.499, do NOT apply to the instant application, which is a 35 U.S.C. §371 national stage application. (*See,* the 6/04 Office Action, p. 2, 1st ¶).

The Original Election Requirement

In Paper No. 8, the Examiner required the election of a single invention for examination and prosecution on the merits. More specifically, the Examiner required that "applicants must elect one ultimate mixture for examination." (*See,* Paper No. 8, p. 2). The Examiner contended that the application contains claims directed to "plural compositions comprising a mixture of two or more different compounds." (*See, id.*). The Examiner also contended that "[e]ach mixture constitutes a unique special technical feature because each compound possesses unique properties based on its structure." (*See, id.*). The Examiner also noted that "[t]he compounds are specified as a1, a2, a3 and a4 in claim 1." (*See, id.*). Finally, the Examiner also required that "[i]f applicants elect a3 as one of the components of the mixture one ultimate a3 must be elected from claim 22." (*See, id.*). On the basis of the foregoing arguments and contentions, the Examiner required the election of a "single mixture".

In the 6/04 Office Action, the Examiner deems the Requirement "proper" and makes it final. The Examiner dismisses Applicants' argument that "groups of claims must be provided." (*See,* the 6/04 Office Action, p. 2). The Examiner simply states that, "the restriction requirement here constituting elections of species, are within a group. . . . [t]hus, the cited rule does not apply." (*See, id.*).

Traversal Arguments

First, the Examiner is incorrect as to the applicability of 37 C.F.R. §1.499. It is clear and well-settled that PCT Unity of Invention practice applies to U.S. national applications filed under 35 U.S.C. §371. U.S. patent applications based upon national stage filings of PCT applications designating the U.S. are examined under PCT rules for Unity of Invention, not ordinary restriction practice. **As set forth in the M.P.E.P., "Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage (filed under 35 U.S.C. 371) applications."** (*See,* M.P.E.P., 8th Edition, Revision 1, §1893.03(d)).

Section 1893.03(d) of the M.P.E.P., 8th Edition, Revision 1, clearly explains 37 C.F.R. §1.499, which governs **Unity of Invention** during the national stage, **while making no distinction between "restriction" and "species election"**, as follows: "[w]hen making a lack of unity of invention requirement, the examiner **must** (1) list the different groups of *claims* and (2) explain why each group lacks unity with each other group (*i.e.*, why there is no single general inventive concept) specifically describing the unique special technical feature in each group." (*See,* M.P.E.P. §1893.03(d), (*emphasis added*)).

Unity of Invention practice does not make a distinction between "restriction" and "species election" practice because Unity of Invention is based upon the presence or absence of a common special technical feature among the several inventions, not the "separate and distinct" criteria upon which ordinary U.S. restriction and species election practice are based.

Applicants submit that despite the Examiner's unsupported legal conclusion to the contrary, 37 C.F.R. §1.499 does, most certainly, apply to the alleged legal substantiation for the Examiner's Election Requirement. In order for the Examiner to legally require an election of a single invention in the instant §371 national stage application, the Examiner must follow the criteria set forth in 37 C.F.R. §1.499.

The Examiner has not identified any groups of claims which allegedly constitute separate inventions. Moreover, the Examiner has not explained how any one group of claims lacks unity with another group of claims.

The law requires the Examiner to identify groups of claims and explain why each group lacks unity of invention with the others.

Finally, Applicants respectfully note that the PCT authorized officer who handled the instant application during the international stage did not have an objection based upon unity of invention.

Therefore, Applicants respectfully submit that the election requirement of a single disclosed invention for prosecution on the merits is improper, and again request reconsideration by the Examiner, withdrawal of the original election requirement, and concurrent prosecution on the merits of all pending claims and subject matter embodied therein.

Respectfully submitted,

WERNER SEIPEL, *et al.*

February 24, 2005
(Date)

By: _____

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